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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/716,722	11/20/2000	Philippe Leyendecker	PF990077	9571

24498 7590 03/22/2005

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EXAMINER

TRAN, THAI Q

ART UNIT	PAPER NUMBER
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2616

DATE MAILED: 03/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

4

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/716,722		LEYENDECKER, PHILIPPE	
	<b>Examiner</b>		<b>Art Unit</b>	
	Thai Tran		2616	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 5-20 is/are rejected.
- 7) ☒ Claim(s) 1-4 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 November 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/20/2000</u> . | 6) <input type="checkbox"/> Other: ____.  |

## **DETAILED ACTION**

### ***Specification***

1. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

2. The abstract of the disclosure is objected to because it is not a single paragraph. Correction is required. See MPEP § 608.01(b).

### ***Drawings***

3. The drawings are objected to under 37 CFR 1.83(a). Legends are required for symbolic blocks of Figs. 1-2 (see MPEP 608.02). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet,

and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Objections***

4. Claims 1-4 and 9-17 are objected to because of the following informalities: There is no element or step for performing functions recited in claims 1-4 and 9-17. Appropriate correction is required.

***Claim Rejections - 35 USC § 101***

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 5-7 and 18 are rejected under 35 U.S.C. 101 because claims 5-7 and 18 are directed to a recording medium containing video stream or video stream.

Data structures not claimed as embodied in computer-readable media are descriptive material per se and are not statutory because they are neither physical "things" nor statutory processes. See, e.g., Warmerdam, 33 F.3d at 1361, 31 USPQ2d at 1760

(claim to a data structure per se held nonstatutory) and, when non-functional

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descriptive material is recorded on some computer-readable medium, it is not structurally and functionally interrelated to the medium but is merely carried by the medium, merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. See MPEG 2106.IV.B.1.

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 5, 7, 9-16, and 18-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Park (5,757,909).

Regarding claim 5, Park discloses a recording medium (the tape of VCR 9 disclosed in col. 11, lines 35-45 and col. 3, lines 31-38) containing the data of a scrambled digital video stream as well as additional data relating to the video data of the stream for the operation of the special mode or “trick mode”.

Regarding claim 7, Park discloses an MPEG audio video digital data stream (col. 3, lines 3-38), comprising additional data (an adaptation header region disclosed in col. 3, lines 3-38) allowing the extraction of the information required by at least one function of the “trick mode”, said additional data being transported in the “adaptation field” of the stream.

Regarding claim 9, Park discloses a process for recording on a recording medium (the keystreams disclosed in col. 11, lines 35-45), a scrambled digital video

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stream, wherein the stream is descrambled in such a way as to extract additional data relating to the keys for enciphering this scrambled stream and in that these data are also recorded on the recording medium (col. 11, lines 35-45 and col. 12, line 55 to col. 13, line 9).

Regarding claim 10, Park also discloses the claimed wherein the additional data relating to the keys are the pointers of the packets in which the keys are to be found and pointers of packets to which these keys are applied (col. 11, lines 35-45 and col. 12, line 55 to col. 13, line 9).

Regarding claim 11, Park discloses the claimed wherein the pointers of packets to which these keys are applied are the pointers defining the stream portions to which the keys are applied (col. 11, lines 35-45 and col. 12, line 55 to col. 13, line 9).

Regarding claim 12, Park discloses the claimed wherein the pointers to the stream portions to which the keys are applied are obtained from the information concerning a change of value of the "transport\_scrambling\_control" field of the scrambled MPEG stream (col. 9, lines 21-24).

Regarding claim 13, Park discloses the claimed wherein the pointers of packets to which these keys are applied are pointers defining a stream segment to which each of the two keys of a pair of keys is applied in succession (col. 12, line 55 to col. 13, line 9 and col. 15, lines 14-16).

Regarding claim 14, Park discloses the claimed wherein the enciphered keys are extracted for the stream so as to be recorded with the additional data relating to the keys (col. 11, lines 35-45).

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Regarding claim 15, Park discloses the claimed wherein the additional data relating to the keys are the deciphered keys (col. 12, line 55 to col. 13, line 9).

Regarding claim 16, Park discloses the claimed wherein the additional data relating to the keys are also the deciphered keys then reciphered with another enciphering device (col. 13, lines 10-36).

The recording medium claim 18 is rejected for the same reasons as discussed in claim 9 above.

Regarding claim 19, Park discloses a process (col. 12, line 55 to col. 13, line 9) for decoding a scrambled MPEG stream recorded on a recording medium, for implementing a special mode ("trick mode"), comprising the following steps:

the reading, from the recording medium, of scrambled data of the MPEG stream (col. 12, lines 55-65),

the reading, from the recording medium, of additional data other than the scrambled data of the MPEG stream, corresponding to information relating to the enciphering keys used for the scrambling (col. 12, lines 55-65),

descrambling of the MPEG stream data read as a function of the additional data read (col. 12, line 66 to col. 13, line 9).

Regarding claim 20, Park discloses a process (col. 12, line 55 to col. 13, line 9) for decoding a scrambled MPEG stream recorded on a recording medium, for implementing a special mode ("trick mode"), comprising the following steps:

reading, from the recording medium, of additional data, other than the scrambled data of the MPEG stream, corresponding to information required by at least one

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function of the special mode or "trick mode" (fast forward, fast rewind, accelerated motion, slow motion, etc.) (col. 12, lines 55-65 and col. 3, lines 31-38),

reading, from the recording medium, of scrambled data of the MPEG stream as a function of the said additional data (col. 12, lines 55-65 and col. 3, lines 31-38).

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 6, 8, and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Park (US 5,757,909).

Regarding claim 6, Park discloses an MPEG scrambled audio video digital data stream as discussed in claim 7 above except for providing wherein the video data packets are scrambled with the exception of the packets containing a start of image.

Park also teaches that the bitstream can be selectively scrambled (Fig. 11C, col. 8, lines 25-27).

It would have been obvious to one of ordinary skill in the art at the time of the invention to selectively scramble the video bitstream with the exception of the packets containing a start of image as taught by Park since it merely amounts to selecting packets to be scrambled.

A process claim 8 is rejected for the same reasons as discussed in the data stream claim 6 above.



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Regarding claim 17, Park discloses all the claimed limitations as discussed in claim 9 above except for the claimed wherein the recording medium is a hard disk or a recordable DVD.

It is noted that hard disk and recordable DVD have random access capability is old and well known in the art and; therefore, Official Notice is taken.

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the well known random access hard disk or recordable DVD into Park's system in order to decrease the time in searching for the desired data recorded in the recording medium because of random access capability.

***Allowable Subject Matter***

11. Claims 1-4 would be allowable if rewritten to overcome the objection set forth in this Office action.

The closest prior art, Park (US 5,757,909), either singularly or in combination, fail to anticipated or render the limitations "wherein the scrambled data of said stream are, in parallel with their recording, descrambled so as to extract therefrom additional data corresponding to information required by at least one function of the special mode or "trick mode" (fast forward, fast rewind, accelerated motion, slow motion, etc.) and wherein these additional data are also recorded on the recording medium" as recited in claim 1.

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The cited references relate to scrambling/descrambling video signal.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thai Tran whose telephone number is (571) 272-7382.

The examiner can normally be reached on Mon. to Friday, 8:00 AM to 5:30 PM.

The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TTQ

  
THAI TRAN  
PRIMARY EXAMINER